

Application No. **10/632,372**
Amendment dated **April 4, 2006**
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REMARKS

I. Introduction

The application has been carefully reviewed in light of the Office Action dated January 4, 2006. This communication is believed to be a timely and complete response to that Office Action. Claims 1, 2, 5, and 7-23 were pending in the present application prior to entry of the present amendments. By the present Office Action Claims 1, 2, 5, and 7-23 have been rejected.

By the present amendment, Claims 1, 8, 13-15, 17, 18 and 23 have been amended. Claims 7 and 16 have been canceled. No new Claims have been added. Claims 2, 5, 9-12, and 19-22 also remain in the application, and upon entry of the present amendment, Claims 1, 2, 5, 8-15, and 17-23 are present.

Support for these amendments can be found in the original specification, and thus, no new matter has been added. Applicant reserves the right to pursue all original Claims in this or other patent applications. Reconsideration and reexamination of the present application is respectfully requested in light of the foregoing amendments and in view of the following remarks, which establish that the pending Claims are directed to allowable subject matter.

II. SUMMARY OF THE AMENDMENTS

In the Claims

Claims 1, 8, 13-15, 17, 18 and 23 have been amended. Claims 7 and 16 have been canceled. No Claims have been added.

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III. CLAIM REJECTIONS

Under 35 U.S.C. § 112

The Examiner has rejected Claims 13, 14, 18, and 23 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner states that "[i]n line 1 of each of Claims 13 and 14, 'separable' is unclear with respect to what is being claimed." (Office Action page 2). Claims 13 and 14 have been amended to remove the word "separable".

The Examiner states that "[i]n claim 18, 'said fold line' lacks antecedent basis in the claims." (Office Action page 2). Claim 18 has been amended to depend from Claim 17, which provides antecedent basis.

The Examiner also states that "[c]laim 23 is unclear with respect to what the trough is formed further from." (Office Action page 2). Claim 23 has been amended to clarify that the word "further" is used as an adjective meaning that the trough is additionally formed from said top and side panels.

Under 35 U.S.C. § 102

Bates et al.

The Examiner has rejected Claims 1, 2, 5, 12, and 15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,929,172 to **Bates et al.** (hereinafter referred to as **Bates**). The Examiner states that "the push tab [90,

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92] is formed from the displaceable portion in the closed carton and forms a recess insofar as claimed." (Office Action page 3).

Bates fails to disclose all of the limitations of amended Claim 1

Bates does not disclose said push tab being hingedly connected to said displaceable portion, as recited in amended Claim 1. Claim 1 has been amended to recite, in part:

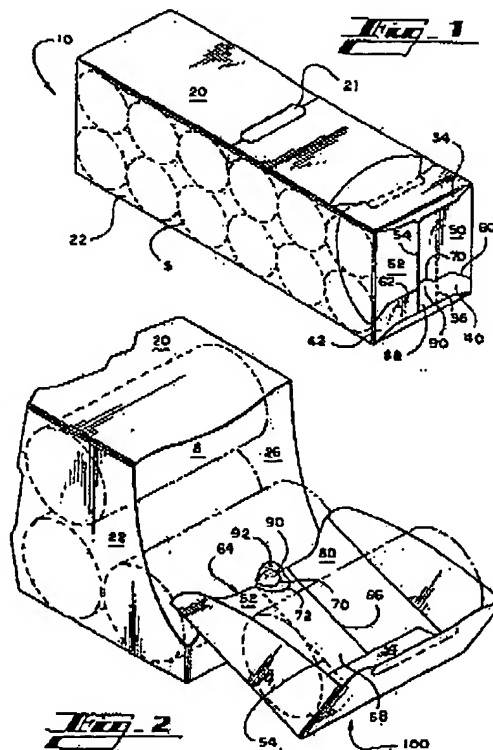
a displaceable portion detachably connected to said carton end to be at least partially detached from said carton for exposing an endmost article for removal from said carton, said displaceable portion at least partially defined by a frangible line in said carton end; and an opening assist defined in said end of said carton such that said opening assist at least partially traverses said seam, wherein said opening assist comprises a push tab defined at least in part by a segment of said frangible line, said segment extending entirely across said seam to facilitate detachment of said displaceable portion along said segment, **said push tab being hingedly connected to said displaceable portion** to be movable from an initial position to a pushed position where said push tab extends into said carton, said push tab being formed at least in part from said displaceable portion such that a recess is defined in said displaceable portion upon movement of said push tab into said pushed position.

Emphasis Added.

In contrast, the protrusions 90, 92 in **Bates** are connected to lower portions 40, 42 of the composite wall and are clearly not hingedly connected to

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the trough 100, which is separable from the carton 10 along frangible lines 60, 62 and weakened line segments 70, 72. See, e.g., FIGs. 1 and 2 of *Bates*, reproduced below. For at least these reasons, Claim 1 and its dependent claims are patentable over the cited art.



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Bates fails to disclose all of the limitations of amended Claim 15

Claim 15 has been similarly amended to recite, in part, "a push tab being hingedly connected to said displaceable portion." The protrusions 90, 92 in **Bates** are connected to lower portions 40, 42 of the composite wall and separable from the trough 100 along weakened line segments 70, 72. Thus, the protrusions 90, 92 are not hingedly connected to the trough 100 and are otherwise not connected to the trough 100. For at least these reasons, Claim 15 is not anticipated by the cited art.

Holley, Jr.

The Examiner has rejected Claims 1, 5, 7, 10, 12, 15, and 16 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,176,419 to **Holley, Jr.** The Examiner states that "it is noted that no distinction is seen between the claimed push tab and the tab 83 as a result of the intended use of the tab to be used as an opening assist, i.e. the tab 83...is considered capable of being pushed to separate the displaceable portion" and "movement of the tab 83 inwardly is considered to produce a recess adjacent edges 84, 86 as claimed." (Office Action page 3). Applicant respectfully traverses this rejection and requests reconsideration and withdrawal thereof.

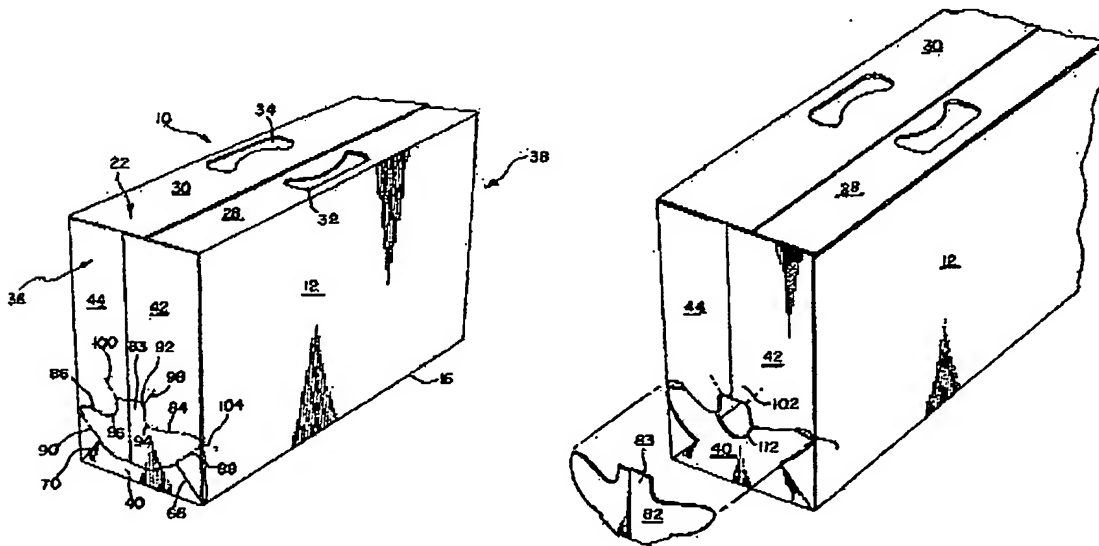
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Holley, Jr. fails to disclose all the limitations of amended Claim 1

Holley, Jr. clearly teaches away from the pull tab 83 being pushed to separate the tear panel 82. In fact, **Holley, Jr.** discloses in column 5 lines 32-38:

[T]he access tab 102 is manually pressed inwardly of the carton, and thereby the access tear lines 98 and 100 and the arched portion 92 of the upper tear lines are broken to render the pull tab 83 accessible. The pull tab 83 is then held by the user's fingers and pulled downwardly to resume breaking of the upper tear lines 84 and 86.

Further, even if the pull tab 83 were to be pushed inwardly to separate the tear panel 82 from the carton 10, a recess would be defined in the side end flaps 42, 44 rather than in the tear panel 82. FIGs. 1 and 2 of **Holley, Jr.** are reproduced below. For at least these reasons, Claim 1 and its dependent claims are patentable over the cited art.



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Holley, Jr. fails to disclose all the limitations of Claim 10

Claim 10 is depends from Claim 8, which recites, in part, "wherein said push tab is at least partially defined by a fold line...and wherein said fold line and said segment of said frangible line are displaced from one another." The pull tab 83 in ***Holley, Jr.*** is not defined by a fold line nor, more specifically, a fold line which is displaced from the tear line portion 92 and the tear line curved portions 94, 96. Further, even if the pull tab 83 were to be folded to create a fold line, the fold line would necessarily extend between and connect with the tear line curved portions 94, 96. Therefore, such a fold line would not be displaced from the curved portions 94, 96, which are considered part of the segment of the frangible line which defines the pull tab 83. Thus, ***Holley, Jr.*** fails to disclose all the limitations of Claim 8 and therefore, for at least these reasons, Claim 10 is patentable over the cited art.

Holley, Jr. fails to disclose all the limitations of amended Claim 15

Claim 15 recites, in part, "a recess is defined in said displaceable portion upon movement of said push tab into said pushed position". In column 5 lines 32-38, ***Holley, Jr.*** clearly teaches away from the pull tab 83 being pushed to separate the tear panel 82. Further, even if the pull tab 83 were to be pushed inwardly to separate the tear panel 82 from the carton 10, a recess would be defined in the side end flaps 42, 44 rather than in the tear panel 82. For at least these reasons, Claim 15 and its dependent claims are patentable over the cited

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art. Claim 16 has been canceled and the rejection to that Claim is considered moot.

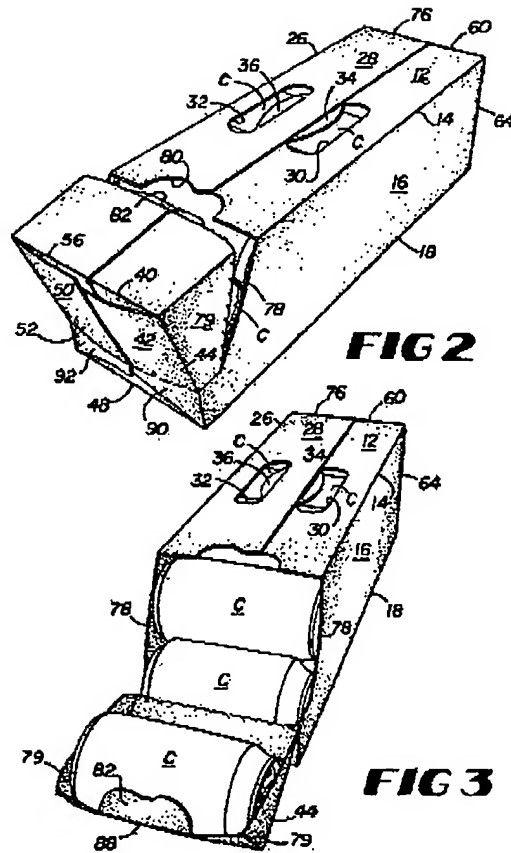
Spivey

The Examiner has rejected Claims 13 and 14 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,578,736 to **Spivey**. The Examiner states that "**Spivey** discloses a trough formed from an end area of a carton and including a push tab 82 formed by overlapping panels 12, 28 forming the end area of the carton as claimed." (Office Action page 4).

Spivey fails to disclose all the limitations of amended Claim 13

Spivey fails to disclose at least a "trough having a fold line displaced from an edge of said trough that is defined by said frangible line" as recited in amended Claim 13. Rather, the fold line 88 in **Spivey** is connected to the tear lines 78, 80 which define the edge of the dispenser 79. FIGs. 2 and 3 of **Spivey** are reproduced below. In addition, **Spivey** discloses in column 4, lines 5 and 6: "Finger flap 82 and insertion flap 86 are connected to the dispenser 79 by fold line 88 which interrupts the tear line 78." For at least these reasons, Claim 13 and its dependent Claim 14 are patentable over the cited art.

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Under 35 U.S.C. § 103(a)

The Examiner has the burden of establishing a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. § 103(a). The CAFC (and the CCPA before it) has repeatedly held that, absent some teaching or suggestion in a primary reference supporting a modification or combination of references, an arbitrary modification of the primary reference or combination of references is improper. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987). Also, the Federal Circuit has held that it is improper to modify a reference in a way that destroys the intent, purpose, or function of the invention disclosed in the reference. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

To establish *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. See e.g., *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996). See MPEP. § 2142.

In view of the foregoing, the Examiner has failed to make out a *prima facie* case of obviousness in support of the rejections of these claims. Each of

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the Examiner's rejections will now be discussed in view of the above prevailing case law.

Spivey in view of Harrelson

The Examiner has rejected Claims 1, 2, 5, 7-12, and 20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,578,736 to ***Spivey*** in view of U.S. Patent No. 6,866,185 to ***Harrelson***. Claim 7 has been canceled and thus the rejection of that claim is considered moot. The rejections of the remaining claims over ***Spivey*** in view of ***Harrelson*** are respectfully traversed.

There is no motivation to combine *Spivey* and *Harrelson*. Moreover, no combination of *Spivey* and *Harrelson* discloses, teaches, or suggests all of the limitations of the rejected claims.

There must be some suggestion or motivation to combine reference teachings. MPEP § 2142. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). MPEP § 2143.01.

The Office Action states that "***Spivey*** discloses all structure of the claimed carton except formation of the push tab [82] such that a recess is defined in the displaceable portion when the tab is pushed" but incorrectly asserts that "***Harrelson*** teaches that it is known to make a push tab 60 within the body of a displaceable portion 59 such that a recess or indent is formed in the displaceable

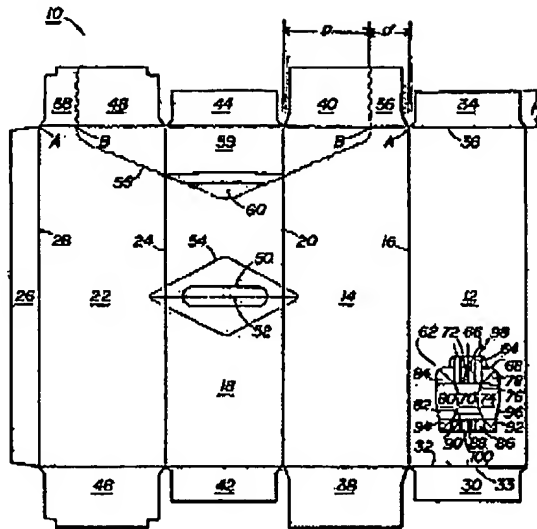
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portion when the tab is pushed inwardly." (Office Action page 4). As demonstrated below, Harrelson does not include this limitation. Even assuming, *arguendo*, the existence of these limitations in the cited references, no motivation or suggestion to combine these references to obtain the claimed invention is presented. Rather, the Office Action impermissibly resorts to hindsight based upon the applicant's disclosure. MPEP § 2142.

The combination of *Spivey* and *Harrelson* fails to disclose all of the limitations of amended Claim 1

Claim 1 recites, in part, "a recess is defined in said displaceable portion upon movement of said push tab into said pushed position." Neither ***Spivey*** nor ***Harrelson*** disclose a recess that is defined in the respective dispenser 79 and dispensing flap 59. Rather, in FIG. 2, ***Spivey*** discloses a recess is defined in overlapping top flaps 12, 28 upon movement of finger flap 82 into a pushed position, and ***Harrelson***, in FIG. 1, discloses a recess that is defined in the top panel 18 upon movement of finger flap 60 into a pushed position. Since neither of the cited prior art references disclose at least the above limitations of Claim 1, ***Spivey*** and ***Harrelson*** when combined fail to teach or suggest all the limitations of Claim 1, either as originally filed or as amended. FIG. 2 of ***Spivey*** is reproduced above and FIG. 1 of ***Harrelson*** is reproduced below. For at least these reasons, Claim 1 and its dependent claims are patentable over the cited art.

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Neither Spivey nor Harrelson discloses the limitations of Amended Claim 8.

The Examiner states that "it is noted that the distal end of the tab is considered to be displaced from the foldline in either Spivey or Harrelson." (Office Action page 5). Claim 1 recites, in part, "a push tab defined at least in part by a segment of said frangible line" and Claim 8 recites, in part, "said push tab is at least partially defined by a fold line...and wherein said fold line and said segment of said frangible line are displaced from one another." Amended Claim 8 depends from Claim 1. It appears that the Examiner misunderstands the Applicant's meaning, in that "displaced from one another" is intended to indicate that the fold line and the frangible line segment are disposed apart from one another. Neither reference teaches or discloses such a relationship.

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In FIGs. 2 and 3, **Spivey** discloses a finger flap 82 defined by a fold line 88 and tear line 80 (considered to be a segment of tear line 78 in that both tear lines 78, 80 define the edge of the dispenser 79). The ends of the fold line 88 and the segment of frangible line 80 clearly connect and, therefore, the fold line 88 and the tear line 80 are not displaced from one another. In FIG. 1, **Harrelson** discloses a fold line connecting the finger flap 60 and the dispensing flap 59. The finger flap 60 is defined by the fold line and the tear line 55. The ends of the fold line and the tear line 55 clearly connect and, therefore, the fold line and the tear line 55 are not displaced from one another. For at least these reasons, Claim 8 and its dependent claims are patentable over the cited art.

Spivey in view of Harrelson fails to disclose the limitations of Claim 11

Claim 11 depends from Claims 1 and 8, and thus is patentable for the reasons presented above, as well as for at least the following reasons. Claim 11 recites, in part, "said push tab is defined further by a pair of tear lines each extending between said fold line and said segment of said frangible line." **Spivey** fails to disclose tear lines that define the finger flap 82 and which extend between the fold line 88 and the tear line 80 (which is considered to be a segment of the tear line 78). **Harrelson** similarly fails to disclose tear lines that define the finger flap 60 and extend between the fold line (connecting the finger flap 60 and the dispensing flap 59) and the segment of tear line 55 that defines the finger flap 60. Since neither of the cited prior art references disclose at least

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the above limitation of Claim 11, the combination of **Spivey** and **Harrelson** cannot teach or suggest all the limitations of Claim 11.

The Examiner stated that "[i]t would have been obvious to make the push tab in Spivey as taught by Harrelson to allow easier tearing of the end of the displaceable portion, i.e. tearing along straight angled tear lines is easier than tear lines perpendicular to the pulling direction." (Office Action page 4). However, angled tear lines are not recited in the claims and do not define a push tab as claimed.

Killey in view of Holley, Jr.

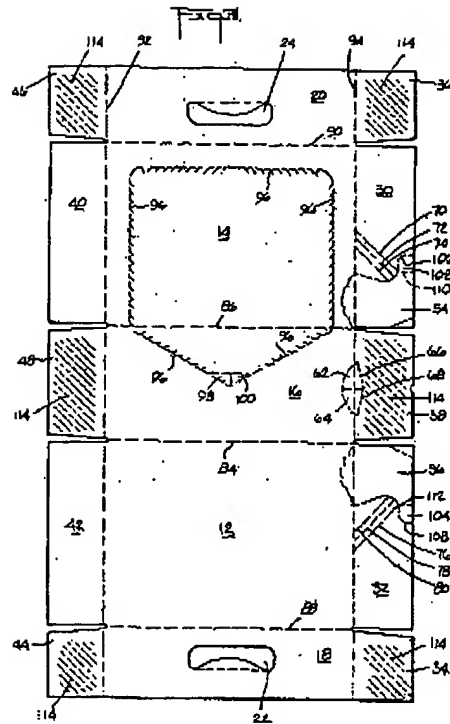
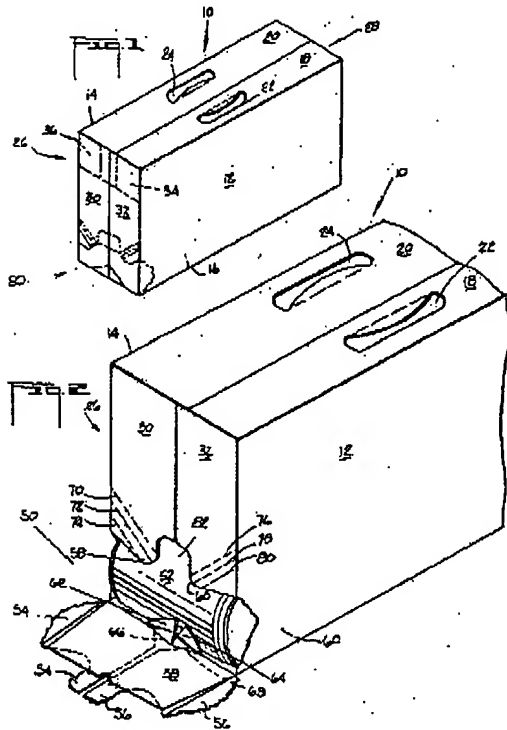
The Examiner has rejected Claims 1, 2, and 5-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,396,143 to **Killey** in view of U.S. Patent No. 6,176,419 to **Holley, Jr.** The Examiner states that "**Killey** discloses all structure of the claimed carton except formation of the opening assist (54, 56) push tab along an overlapping seam formed by the end of the carton. **Holley, Jr.** teaches that it is known to make the opening assist on a displaceable portion at the end of a carton along the seam formed between two overlapping flaps." (Office Action page 5). Claims 6 and 7 have been cancelled and the rejections of these Claims are considered moot.

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The combination of *Killey* and *Holley, Jr.* fails to disclose all of the limitations of amended Claim 1

Claim 1 recites, in part, "a recess is defined in said displaceable portion upon movement of said push tab into said pushed position." Neither *Killey* nor *Holley, Jr.* disclose a recess that is defined in the respective torn out portions 54, 56 and tear panel 82. Rather, the finger hole 82 in *Killey* is defined in left and right end closure flaps 30, 32 upon movement of finger tabs 102, 104 into a pushed position. The recess in *Holley, Jr.* is defined in the side end flaps 42, 44 upon movement of pull tab 83 or access tab 102 into a pushed position. Since neither of the cited prior art references disclose at least the above limitations of Claim 1, the combination of *Killey* and *Holley, Jr.* fails to disclose all of the limitations of amended Claim 1. FIGs. 2 and 3 of *Killey* are reproduced below and FIG. 1 of *Holley, Jr.* is reproduced above. For at least these reasons, Claim 1 and its dependents are patentable over the cited art.

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Neither *Killey* nor *Holley, Jr.* disclose the limitations of amended Claim 8

Amended Claim 1 recites, in part, "a push tab defined at least in part by a segment of said frangible line" and amended Claim 8 recites, in part, "said push tab is at least partially defined by a fold line...and wherein said fold line and said segment of said frangible line are displaced from one another." Amended Claim 8 depends from amended Claim 1.

Finger tabs 102, 104 of *Killey* are defined by straight score lines 110, 112 and curved score lines 106, 108. An end of each of the straight score line 110,

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112 is clearly connected to the respective curved score line 106, 108 and, therefore, the straight score line 110/112 and curved score line 106/108 are not displaced from one another. **Holley, Jr.** fails to disclose a fold line connecting the pull tab 83 to the tear away panel 82. Further, **Holley, Jr.** teaches away from pushing the pull tab 83 and even if the pull tab 83 is pushed, the pull tab 83 would fold along a line that extends between the curved portions 94, 96 that define the pull tab 83. Thus, the ends of the fold line and the curved portions 94, 96 would clearly connect and, therefore, the fold line and the curved portions 94, 96 are not displaced from one another. Neither of the cited prior art references disclose at least the above claim limitations and thus, for at least these reasons, Claim 8 and its dependents are patentable over the cited art.

Killey in view of Holley, Jr. fails to disclose the limitations of Claim 11

Claim 11 recites, in part, "said push tab is defined further by a pair of tear lines each extending between said fold line and said segment of said frangible line." Neither **Killey** nor **Holley, Jr.** disclose at least these of Claim 11. The finger tabs 102, 104 in **Killey** are defined by a straight score line 110/112 and a curved score line 106/108, but are not defined by a pair of tear lines extending between the straight score line 110/112 and the curved score line 106/108. **Holley, Jr.** discloses a pull tab 83 that is defined by the straight portion 92, curved portions 94, 96 and a fold line which is assumed to be formed upon

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pushing the pull tab 83. The straight portion 92 and the curved portions 94, 96 are considered to be the segment of the frangible line which defines the pull tab 83. **Holley, Jr.** fails to disclose tear lines which further define the pull tab 83 in addition to the straight portion 92, curved portions 94, 96, and fold line. Since neither of the prior art references disclose at least the above limitations of Claim 11, the combination of Killey and Holley, Jr. fail to disclose the limitations of Claim 11. For at least these reasons Claim 11 is patentable over the cited art.

Killey in view of Holley, Jr. fails to disclose the limitations of amended Claim 15

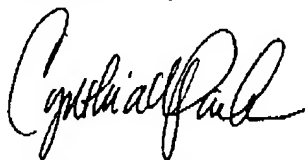
Claim 15 recites, in part, "a recess is defined in said displaceable portion upon movement of said push tab into said pushed position." Neither **Killey** nor **Holley, Jr.** disclose a recess that is defined in the respective torn out portions 54, 56 and tear panel 82. Rather, in FIGs. 2 and 3, a finger hole 82 of **Killey** is defined in left and right end closure flaps 30, 32 upon movement of finger tabs 102, 104 into a pushed position. In FIG. 1, a recess of **Holley, Jr.** is defined in the side end flaps 42, 44 upon movement of pull tab 83 or access tab 102 into a pushed position. Since neither of the cited prior art references disclose at least the limitations of amended Claim 15, the combination of Killey and Holley, Jr. fail to disclose the limitations of amended Claim 15. For at least these reasons, Claim 15 and the claims that depend therefrom are patentable over the cited art.

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IV. CONCLUSION

For at least the above reasons, Applicant respectfully requests allowance of the Claims pending in this case and issuance of a patent containing these Claims in due course. Should Examiner Elkins believe that a telephone conference would be useful to resolve any concerns and move this application to allowance, Examiner Elkins is respectfully requested to contact the undersigned at the telephone number listed below. Otherwise, Applicant respectfully requests timely issuance of a Notice of Allowance for the present application.

Respectfully submitted,



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